IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.   10/777,478

Applicant(s):   Nicola Funnell

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Group Art Unit: 2617

Examiner: Manoharan, Muthuswamy Ganapathy

Title: Apparatus and Method for Handling System Information in Mobile
                    Telecommunications System User Equipment

Docket No: 1578.607 (11758-US-PAT)

Customer No.:   44208

Commissioner of Patents
P.O.Box 1450
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection in the above captioned application for patent. No amendments are filed with this request. This request is filed with a Pre-Appeal Brief Request for Review and a Notice of Appeal.

REMARKS SUPPORTING REQUEST FOR REVIEW

Summary

Claims 1-3 and 7-10 have been finally rejected under 35 U.S.C. § 103(a). Applicant has argued and continues to assert that the rejection of the claimed invention under 103 is improper because the combination fails to disclose every aspect of the claimed invention.

Status of the Application

The present application has been finally rejected under 35 U.S.C. §103(a) as set forth in the Office Action dated 2/9/2011 and confirmed in the Advisory Action of 5/12/2011. All pending claims have been rejected. Applicant herewith files a Notice of Appeal.

Remarks

In the Office Action of 3/12/2011 and Advisory Action of 5/12/11, claims 1-3 and 7-10 were rejected under 35 U.S.C. §103(a) over 3GPP (TS 25.331 v3.16.0 (2003-9)) (hereinafter Reference A) in view of US Patent Application Publication No. 2003/0040312 to Tohono, hereinafter Tohono.

In the rejection of claim 1, the Examiner acknowledged that the 3GPP document does not provide a predefined order for applying system information associated with SIB information elements but relied upon Tohono for disclosing a predefined order for applying system information with SIB information elements. The Examiner specifically relied upon Tohono for showing the predefined order being to act on system information associated with an IE in a SIB of type 11 and then upon system information associated with a same type of IE in a SIB of type 12. Claim 7 was rejected based upon a corresponding rationale.

SIB 11 relating to idle and connected mode, and SIB 12 relating to connected mode; both SIB 11 and SIB 12 relating to measurement information

The Examiner relied upon paragraphs 56-59 of Tohono to demonstrate Tohono's relevance to the claimed method comprising SIB 11 and SIB 12. There is no mention in this cited portion, nor elsewhere in Tohono, of system information relating to SIB 11 or SIB 12 nor any correspondence between SIB 11 and SIB 12, nor of the idle and connected mode, nor of the connected mode.

Additionally, the claims state that these SIBs relate to *measurement information* of type 11 and type 12. This differs with the mere reference in Tohono to active and candidate cells.

The Examiner stated that it is well know that a cell information list corresponding to the active cell reads on SIB 11 and that a cell information list corresponding to handover destination candidate cell reads on SIB 12. The claims state that SIB 11 relates to both the idle *and* connected modes, and SIB 12 relates to connected mode. The active and hand-over cells in Tohono cannot, therefore, correspond to SIB 11 and SIB 12. The amended claims therefore recite a method in which the SIB 11 and SIB 12 are different than the Examiner's asserted equivalency.

In summary, Tohono fails to disclose receiving SIB 12, and SIB 11; and then determining whether a same IE type is included in each of the SIB 11 and SIB 12; and thereafter, acting upon the system information associated with SIB 11 then SIB 12 when it is determined that the same IE type is included.

determining if a same IE type is included in each of a received SIB 11 and a received SIB 12; and responding to the result of the determination

Tohono is concerned with controlling search timing using a cell search method. See paragraphs [0013] and [0015] of Tohono. And, paragraph [0056], specifically relied upon by the Examiner in the rejection, indicates in its step one that a search of the active cell is performed and that the reception level is then updated. So in Tohono, there is acting upon the information associated with what the examiner identifies as SIB 11 **before** SIB 12 has been received. That is, it is an error to suggest that there is receipt of both features purported to be equivalent to SIB11 and SIB 12 prior to acting upon their information.

It is also incorrect to suggest that in Tohono, as required in the present claims, there is a determination of whether the same IE type is included in what the examiner identifies as SIB 11 and SIB 12. In Tohono, there is acting upon information associated with what the Examiner identifies to be SIB 11 **before** there has been any such determination (or even receipt of SIB 12). In summary, it is not correct to assert that in Tohono there is determining *after* receipt of a SIB 12 and SIB 11 if a same IE type is included in each of the SIB 11 and the SIB 12.

acting upon system information according to predefined order

The examiner states that Tohono relates to application of information in a defined order. However, in the present claims, this acting upon in a defined order is in response to a determination of whether the same IE is included in each of SIB 11 and 12. Thus it is not correct to suggest that there is any suggestion in Tohono of this acting *response to a determination* as claimed in the present claims.

Figure 3 of Tohono illustrates this distinction. Figure 3 shows execution of paging channel receiving cell even prior to detection of a candidate cell. And, Figure 4 of Tohono illustrates updating of reception level and radio timing, without any suggestion of a method in

which SIB 12 and then SIB 11 are both received *first*, before later determining if the same IE type is included, and acting upon the system information associated with the identified same IE types according to a predefined order.

Further, paragraph [0049] of Tohono refers to an aim of Tohono to provide for easily-adjustable cell detection ability of detection time. This disclosure directs away from the recited invention, which provides for a method in which, when SIB 12 and then SIB 11 are received, there is then a determination of a same IE, and if so, application in a defined order.

responding to a determination that the same IE type is included in only one of the SIBs

The Examiner states in the Advisory Action that Tohono teaches responding to a determination that the same IE type is included in only one of the SIBs by applying an IE from the associated one of the SIBs. However, this is not the case. Whilst it may be argued there is application of an IE associated with what the examiner identifies as one of the SIBs, this is in no way "in response to a determination" that the same IE is included in only one of the SIBs, with there being no determination, and no determination after receipt of SIB 12 and SIB 11, of whether the same IE is included in each of SIB 11 and SIB 12.

response to a determination that the same IE is included in both SIBs by acting upon the system information according to a predefined order.

Similarly, the examiner states that in Tohono there is response to a determination that the same IE is included in both SIBs by acting upon the system information according to a predefined order. Once again, there is no actual step of determining, looking to both SIB 12 and SIB 11 which have already been received, of whether a same IE type is included in each, and thereafter responding to a determination. Using the examiner's interpretation, there is at best in Tohono response at the same time as receipt of what the examiner equates as SIB 12 and SIB 11 – as oppose to a response that takes place after determining whether an already received SIB 12 and SIB 11 include the same IE type.

Summary

In summary, the Examiner states in the Advisory Action that the determination step in the claims is ineffective since applying the system information in a predefined order satisfies

4

the step to be performed based on the determination. However, this interpretation suggests a reactive merging of the steps of the three factors of receipt of "SIB"s, determination, and response to determination - with no teaching of their existence (with regards to the determination), and certainly no teaching of their order of application contrasting the present claims. In the present claims it is clear that SIB 12 and SIB 11 are both received first, followed by the determination, followed by the response to the determination. As discussed above, and as illustrated in Figures 3 and 4 of Tohono, acting on the system information in Tohono occurs on receipt of that system information, with no proactive determination step or response thereto taught, and certainly no suggestion of the trio order of joint receipt, determination, and response thereto as set out clearly in the present claims.

Therefore, the Applicants assert that no combination of the cited references can be created to form the invention as now-recited in independent claims 1 and 7.

As the dependent claim include all of the recitations of their respective parent claims, the dependent claims are believed to be patentably distinguishable over the cited references for the same reasons as those given with respect to their respective parent claims.

In view of the foregoing, applicant respectfully requests review of the present application, withdrawal of the final rejection, and allowance of the pending claims.

Respectfully submitted,

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